

REMARKS

Claims 1 through 7 are pending in this application. Applicant acknowledge, with appreciation, the Examiner's indication that claim 3 contains allowable subject matter. Accordingly, the only remaining issue pivots about the patentability of claims 1, 2 and 4 through 7.

Claim 1 has been amended by clarifying that the recited steps are performed sequentially. Claims 4 and 5 have been placed in method format and amended to clarify that the recited steps are performed sequentially. In addition, the informalities identified by the Examiner have been addressed. Applicants submit that adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the second full paragraph on page 6 of the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Claim Objections

The Examiner objected to claims 1, 6 and 7 identifying perceived informalities and courteously suggesting remedial language. In response, the remedial language suggested by the Examiner has been implemented, thereby overcoming the stated bases for the claim objections. Accordingly, withdrawal of the claim objections is solicited.

Claims 1, 4 and 5 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by O'Toole et al.

In the statement of the rejection, the Examiner asserted that O'Toole et al. disclose a method corresponding to that claimed. As to claims 4 and 5, the Examiner asserted that the manner in which the claimed device is made is not germane to the patentability of the device itself. This rejection is traversed.

Initially, Applicants would note that claims 4 and 5 are now in method format. In addition, each of claims 1, 4 and 5 has been amended to clarify that the recited steps are performed **sequentially**. In other words, the claimed methods comprise a **pre-fusion heating step**, as discussed in the first full paragraph on page 6 of the written specification.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Elan Pharmaceuticals Inc. v. Mayo Foundation*, ___ F.3d ___, 64 USPQ2d 1292 (Fed. Cir. 2002); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a significant difference between the claimed method and the methodology disclosed by O'Toole that scotches the factual determination that O'Toole et al. identically describe the claimed invention with the meaning of 35 U.S.C. §102.

Specifically, as apparently appreciated by the Examiner, noting the comments in the ninth enumerated paragraph on page 5 of the March 11, 2003 Office Action, O'Toole et al. neither disclose nor suggest a **pre-fusion heating step** as in the claimed inventions. Rather, in accordance with the methodology of O'Toole et al., a fusion joint is heated.

The above argued fundamental difference between the claimed methods and the methodology of O'Toole et al. undermines the factual determination that O'Toole et al. describe a method identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicants, therefore, submit that the imposed rejection of claims 1, 4 and 5 under 35 U.S.C. §102 for lack of novelty is evidenced by O'Toole et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 6 and 7 were rejected under 35 U.S.C. §103 for obviousness predicated upon O'Toole et al.

Claim 2 was rejected under 35 U.S.C. §102 for lack of novelty or, alternatively, under 35 U.S.C. §103 for obviousness predicated upon O'Toole et al.

Each of the above rejections of claims 6 and 7 and of claim 2 is traversed. Specifically, claims 6 and 7 depend from claims 4 and 5, while claim 2 depends from claim 1. Applicants incorporate herein the argument previously advanced in traversing the imposed rejection of claims 1, 4 and 5 under 35 U.S.C. §102 for lack of novelty as evidenced by O'Toole et al. Specifically, O'Toole et al. neither disclose nor suggest the

concept of implementing a **pre-fusion heating step** to defuse a dopant. As apparently appreciated by the Examiner, in accordance with the methodology of O'Toole et al., dopant diffusion is **not** implemented by heating **prior** to fusion. The Examiner's additional comments with respect to the rejections of claims 6 and 7 and claim 2 do not cure the argued deficiencies of O'Toole et al. Indeed, there is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill in the art would somehow have been realistically impelled to modify the methodology of O'Toole et al. by implementing a pre-fusion heating step to effect diffusion of a dopant, absent improper reliance upon Applicants' disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

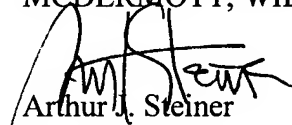
Applicants, therefore, submit that the imposed rejection of claims 6 and 7 under 35 U.S.C. §103 for obviousness predicated upon O'Toole et al., and the imposed rejection of claim 2 under 35 U.S.C. §102 for lack of novelty or, alternatively, under 35 U.S.C. §103 for obviousness predicated upon O'Toole et al., are not factually or legally viable and, hence, solicit withdrawal thereof.

Applicants again acknowledge, with appreciation, the Examiner's indication that claim 3 contains allowable subject matter. Based upon the foregoing, it should be apparent that the imposed objection and rejections have been overcome, and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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